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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,336	03/01/2002	Karen S. Thomann	P04514US0	4139
22885 7590 12/28/2006 MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			EXAMINER CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/086,336

Applicant(s)

THOMANN ET AL.

Examiner

Sara Chandler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "wherein the work is selected from the set comprising". It is unclear whether a Markush group is intended. The claim should be -- wherein the work is selected from the group consisting of --. See MPEP § 2173.05(h).

Claim 7 recites the limitation "the step of identifying client and contract information associated with the work". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1,7-22,28-33, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub. No. 2003/0115073 in view of Schwanke, US Pub. No. 2003/0018508.

Re Claims 1,7-22,31-33: Todd discloses a method comprising:

receiving work at a first location (Todd, abstract, Figs. 6,7,8; [0006] [0046] [0047] [0048] [0059]);

determining identifying information associated with the work (Todd, abstract, Figs. 6,7,8; [0047] [0049] [0052] [0058] [0059] [0060] Inherent, that work that is done manually is done by a worker; see also [0008] [0035] [0060] [0061] [0062])

Also, it is inherent that an identifier will associate the information details of the work such as the account, the client for the account and requirements of the work contract. The purpose of an identifier is to correlate information. For example, identifying the account can also identify the client (e.g., such as the using the last name of the client for the account).

Also, Non-Functional Descriptive: The particular type of identifier specified does not carry patentable weight because it comprises non-functional descriptive material and it does not provide a functional interrelationship. See MPEP §2106.01 [R-5], II building a request based on a type of the work to be completed (Todd, abstract; Figs. 7,8; [0008] [0047] [0058] [0061] [0062] Inherent, that work that is done manually is done by a worker; see also [0008] [0035] [0060] [0061] [0062]);

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at least partially completing the request (Todd, abstract; [0006] [0046] [0047] [0048] [0059] Inherent, that work that is done manually is done by a worker; see also [0008] [0035] [0060] [0061] [0062]); and submitting the request for processing (Todd, abstract, Figs. 6,7,8; [0048] [0049] [0057] [0058] [0059] [0060] [0061] [0062] Inherent, that work that is done manually is done by a worker; see also [0008] [0035] [0060] [0061] [0062]).

Todd fails to explicitly disclose a method of managing workflow.

Schwanke discloses a method of managing workflow (Schwanke, Figs. 1,3,5, [0004] – [0025]; [0035 – [0038]; [0122] – [0124]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Todd by adopting the teachings of Schwanke to provide method of managing workflow comprising: receiving work at a first location; determining identifying information associated with the work; building a request based on a type of the work to be completed; at least partially completing the request; and submitting the request for processing.

As suggested by Schwanke one would have been motivated to use workflow management to support computer-supported human activity.

Re Claims 29-30: Todd fails to explicitly disclose the method further comprising assigning a skill level to the request based on the type of work to be completed; and assigning the step of at least partially completing the request to a worker based on the skill level.

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Schwanke discloses the method further comprising assigning a skill level to the request based on the type of work to be completed (Schwanke, Fig. 3; [0014]); and assigning the step of at least partially completing the request to a worker based on the skill level (Schwanke, Fig. 3; [0014]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Todd by adopting the teachings of Schwanke to provide the method further comprising assigning a skill level to the request based on the type of work to be completed; and assigning the step of at least partially completing the request to a worker based on the skill level.

One would have been motivated by improved efficiency.

Re Claims 37- 38: Todd fails to explicitly disclose the method wherein the work is financial services work; or pension plan work. Analogous Art: It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem to be solved is the management of workflow, which can be done irrespective of the type of work or the industry in which the work falls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Todd and Schwanke to provide a method wherein the work is financial service; or

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pension plan work. As suggested by Schwanke one would have been motivated to use workflow management to support computer-supported human activity.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub. No. 2003/0115073 in view Schwanke, US Pub. No. 2003/0018508 and further in view of Bellotti, US Pub. No. 2003/0135559.

Re Claims 3-6: Todd fails to explicitly disclose a method wherein the work is received in paper form

and further comprising imaging the paper form of the work to create a digital representation of the work;

associating the identifying information with the digital representation of the work; and placing the digital representation of the work in a digital envelope.

Bellotti discloses a method wherein the work is received in paper form (Bellotti, [0006] [0007] [0008])

and further comprising imaging the paper form of the work to create a digital representation of the work (Bellotti, [0006] [0007] [0008]);

associating the identifying information with the digital representation of the work (Bellotti, [0006] [0007] [0008]);

and placing the digital representation of the work in a digital envelope (Bellotti, [0006] [0007] [0008]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Todd and Schwanke by adopting the teachings of Bellotti to provide a method wherein the work is received in paper form and

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further comprising imaging the paper form of the work to create a digital representation of the work; associating the identifying information with the digital representation of the work; and placing the digital representation of the work in a digital envelope.

As suggested by Bellotti, one would have been motivated to automate the flow of paper-based documentation through an organization.

Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, US Pub. No. 2003/0115073 in view of Schwanke, US Pub. No. 2003/0018508 and further in view of Flockhart, US Pat. No. 6,463,346.

Re Claims 23-24: Todd fails to explicitly disclose the method further comprising prioritizing the work received;
and prioritizing the work received at least partially by a manner in which the work is received.

Flockhart discloses the method further comprising prioritizing the work received (Flockhart, abstract, Figs. 3,4; col. 1, line 1+ - col. 2, line 20);
and prioritizing the work received at least partially by a manner in which the work is received (Flockhart, abstract, Figs. 3,4; col. 1, line 1+ - col. 2, line 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Todd and Schwanke by adopting the teachings of Flockhart to provide a method further comprising prioritizing the work received;
and prioritizing the work received at least partially by a manner in which the work is received.

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As suggested by Flockhart, one would have been motivated to provide faster and more efficient completion of assignments.

Re Claims 25-27: Todd fails to explicitly disclose the method further comprising placing the work received into an identity queue;
placing the work identified into a queue; and
placing the request into a queue.

Flockhart discloses the method further comprising placing the work received into an identity queue (Flockhart, abstract, Figs. 3,4; col. 1, line 1+ - col. 2, line 20);
placing the work identified into a queue (Flockhart, abstract, Figs. 3,4; col. 1, line 1+ - col. 2, line 20); and
placing the request into a queue (Flockhart, abstract, Figs. 3,4; col. 1, line 1+ - col. 2, line 20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Todd and Schwanke by adopting the teachings of Flockhart to provide a method further comprising placing the work received into an identity queue;
placing the work identified into a queue; and placing the request into a queue.

As suggested by Flockhart, queues can be part of a work strategy that allows for adjustments in workflow thus allowing for faster and more efficient completion of assignments.

Re Claims 34-36: Todd fails to explicitly disclose the method further comprising:
prioritizing the building of the request based on the identifying information; or

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prioritizing the at least partially completing the request based at least in part on the type of the work; or

prioritizing the submitting of the request for process based at least in part on the type of work.

Flockhart discloses the method further comprising: prioritizing the building of the request based on the identifying information (Flockhart, abstract, Figs. 3,4; col. 1, line 1+ - col. 2, line 20); or

prioritizing the at least partially completing the request based at least in part on the type of the work (Flockhart, abstract, Figs. 3,4; col. 1, line 1+ - col. 2, line 20); or

prioritizing the submitting of the request for process based at least in part on the type of work (Flockhart, abstract, Figs. 3,4; col. 1, line 1+ - col. 2, line 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Todd and Schwanke by adopting the teachings of Flockhart to provide the method further comprising: prioritizing the building of the request based on the identifying information; or prioritizing the at least partially completing the request based at least in part on the type of the work; or prioritizing the submitting of the request for process based at least in part on the type of work.

As suggested by Flockhart, one would have been motivated to provide faster and more efficient completion of assignments.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Tarumi, US Pat. No. 5,918,226- workflow; and

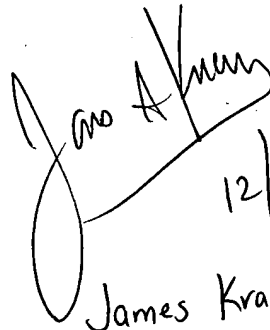
Ohmura, US Pat. No. 6,151,583- workflow.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC


12/21/06
James Kramer